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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,856	01/25/2006	Satoshi Shimomura	D5620-00070	7463
8933 7590 04/15/2009 DUANE MORRIS LLP - Philadelphia IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196				
EXAMINER				
AHMED, MASUD				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
04/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/565,856

**Applicant(s)**

SHIMOMURA ET AL.

**Examiner**

MASUD AHMED

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant has submitted an amendment with an RCE. Claims 1 and 4 are amended.

Examiner has considered the amendment to the claims very carefully and responded to the applicant's argument below.

### ***Response to Arguments***

Applicant's arguments filed on 3/2/2009 have been fully considered but they are not persuasive. Examiner respectfully disagrees with the applicant's for the reason stated to address the amended portion of the claims below.

1. In response to the applicant's argument on "two image data", examiner respectfully disagrees and the reason clearly stated below to address the amendment.

### ***Specification***

1. The abstract of the disclosure is objected to because the abstract contains the reference number of the detailed apparatus and with the acronyms such as CDP .

Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly

those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 1** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example the amended portion of the claim partially recites *"providing a first portion of data in said game playing terminal at a first time, said first portion of data comprising image data corresponding to said present item;*  
  
*providing a second portion of data downloaded into said game playing terminal from said server at a second time different from said first time, said second portion of data*

*comprising image data corresponding to said present item, said first portion of data being a part of said image of said present item, said **second portion of data being a remaining part of said image** of said present item; and producing a **complete image** of said present item by said game playing terminal by **synthesizing** the first and second portions of data. "*

Upon a careful review of the specification examiner could not find a clear support of how the two images put together complete the image data or in this case the game character data. As it best understood by the examiner and shown on figure 4 a, b and c, where a is the game character image, b is the character information data and putting character image together with the character information c is created. fig 4a and fig 4 b are individually complete images as it evident by the applicant's disclosure and drawings therefore it contradicts with the claimed language.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1 and 4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The methods recited in these claims include the judicial exception of an abstract idea (a

method of controlling a game online). No physical transformation is present to establish a practical application of the abstract idea.

As explained in the Interim Guidelines in view of *In re Bilski*, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purpose of 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decision, the Office's guidance to examiners is that a 101 process (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ***This is called "machine-or-transformation test"***. If neither of these is met by the claim, the method is not a patent eligible process under 101 and should be rejected as being non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap (US 2002/0068632).**

Dunlap teaches an online game system where player play using a game card having following limitations:

**Regarding claim 1**, Dunlap teaches an online game system with the user card encoded user password and information (para 0066);

Over the network the encoded password and user information is verified by the server (para 0066);

Upon authenticating the card the player character's value is determined in corresponds with the player account (para 0067);

Upon the verification of the user card information, the player character is downloaded on the player terminal to play game (para 0067);

Once the player character is generated, the character is displayed on the player's terminal and controlled by the player as the game approaches corresponding the player's character strength and lives (para 0070 and 0071);

Player character points are updated by the server as the player character's progresses through the game to achieve higher levels of the game (para 0073, 0074). Dunlap teaches user's item or character is downloaded from the server to the player terminal (para 0067);

Player characters are created or customized by the player also can be used to play games (para 0078, 0069).

Applicant's made the argument that Dunlap does not disclose a portion of the data being on the playing terminal which corresponds to the portion of the data image that is downloaded from the server and further amended the claim to differentiate two different portion of the image put together complete the player character image, It should be noted that this feature of the claimed invention merely an alternative security feature to prevent alteration of the player card value of the game. Dunlap clearly discloses the feature of storing the characteristic data physically in the playing card or can be stored in the server (para 0067 and 0068), further for the enhance security and authentication a user log on or password is required for the system (para 0065). Further reviewing applicant's disclosure it is determined that the first image is the game character itself and second portion of the image is character's data such as life and defense information. On para 0019 through 0036 Dunlap discloses upon identification player character is downloaded to the respective player terminals with their respective key data associated with the identified player such as player lives, health information, strength etc, which is the second portion of the data, therefore it would have been obvious to ordinary skilled artisan at the time of invention to use Dunlap's game system to modify downloading game character image and the game character data at a separate time interval as an alternative security measure to the Dunlap's teachings of authentication.



**Regarding claim 4,** In addition to the teachings and disclosure cited by the examiner above on claim 1, Dunlap's disclosure of user authentication password and user character's various data table such as health, strength and player character's lives are considered as control data that are stored in the server and corresponds the appropriate user upon log in (para 0065-0068).

**Regarding claims 3 and 5,** Dunlap teaches the player character's data to be downloaded along with the player character from the server only once (para 0067); Character strength and lives of the player character is predetermined and can not be manipulated by the player (para 0073 0074).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 10:00am-7:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./  
Examiner, Art Unit 3714

/Peter D. Vo/  
Supervisory Patent Examiner, Art Unit 3714